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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,666	01/23/2004	Leonid C. Lev	GP-303626	9378

7590 09/06/2006
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EXAMINER

LE, HUNG CHARLIE

ART UNIT	PAPER NUMBER
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3663

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,666	Applicant(s) LEV ET AL.	
	Examiner Hung C. Le	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 37 is/are pending in the application.
- 4a) Of the above claim(s) 2 - 4, 11 - 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5 - 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 5 - 10 have been considered but are moot in view of the new ground(s) of rejection.

Note: Claims 2 – 4, 11 – 37 were withdrawn by applicant.

Claim Objections

2. Claim 1 is objected to because of the following informalities:

Line 3: "a first and second cylindrical guide roll ..."

Should be: "a first and second cylindrical guide rolls...".

Appropriate correction is required..

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5 – 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Jury (4,257,251).

With respect to claim 1: Jury discloses: (Abstract, Figs. 1 – 2): An apparatus for plastically deforming a work piece (50) comprising a sheet, the apparatus comprising:

a first and a second cylindrical guide rolls (22, 23) rotatable in a first direction, each of said cylindrical guide rolls having an outer circumference;

a bendable strip (47) having a portion of at least one surface in communication with a portion of the outer circumference of each of the first and second cylindrical guide rolls (22, 23), said bendable strip being capable of motion around the first and second cylindrical guide rolls in the first direction and exerting a force upon the work piece (50),

a first cylindrical feeding roll (31) rotatable in a second direction opposite to the first direction, said first cylindrical feeding roll having an outer circumference,

a plastic deformation passage ((Fig. 1)having a first surface and a second surface, at least a portion of the first surface being defined by a portion of the bendable strip (47), and at least a portion of the second surface being defined by the outer circumference of the first cylindrical feeding roll (31), the plastic deformation passage extending from the first cylindrical guide roll (22) to the second cylindrical guide roll (23),

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wherein one or both of the bendable strip (47) and the cylindrical feeding roll (31), when in motion, propel the work piece (50) through the plastic deformation passage wherein the work piece (50) is plastically deformed.

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

With respect to claim 5: Jury further discloses: (Abstract, Figs. 1 – 2): a plastic deformation passage wherein another portion of the first surface of the plastic deformation passage is defined by a die (48 & 51).

With respect to claim 6: Jury further discloses: (Abstract, Figs. 1 – 2): the die(48 & 51) compresses a deformable work piece (50) between itself and the feeding roll (31).

With respect to claim 7: Jury further discloses: (Abstract, Figs. 1 – 2): wherein the plastic deformation passage further comprises a channel (Fig. 1) defined by an upper and lower die (48 & 51), said upper die (48) being in communication with a portion of the bendable strip (47) and said lower die (51) being in communication with the outer circumference of the feeding roll (31).

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With respect to claim 8: Jury further discloses: (Abstract, Figs. 1 – 2): wherein a single one-piece die (48 & 51) comprises the upper (48) and lower (51) die.

With respect to claim 9: Jury further discloses: (Abstract, Figs. 1 – 2): wherein the upper die (48) is in communication with a portion of the bendable strip that is in communication with one of the cylindrical guide rolls (22, 23).

With respect to claim 10: Jury further discloses: (Abstract, Figs. 1 – 2): wherein the channel is an angled channel (49, Fig. 2).

5. The statements of intended use or field of use, e.g., “for plastically deforming, capable of, etc...” clauses are essentially method limitations or statements or intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung C. Le whose telephone number is 571-272-8757. The examiner can normally be reached on M-F: 07:30am - 05:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information

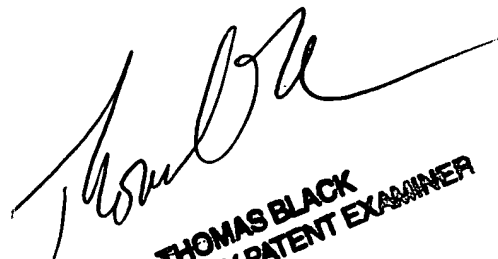
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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HCL
08/28/06



THOMAS BLACK
SUPERVISORY PATENT EXAMINER